UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,065	12/01/2000	Paul E. Jacobs	PA000381	3959

23696 7590 09/28/2004

Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER	
ALVAREZ, RAQUEL	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/728,065	JACOBS ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,18,29,30,32-34,45,46,74-77 and 83-85* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,18,29,30,32-34,45,46,74-77 and 83-85* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/19/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 7/15/2004.

2. Claims 1, 18, 29, 30, 32-34, 45-46, 74-77 and 83-85 are presented for examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 18, 29, 30, 32-34, 45, 46, 74-77 and 83-85 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40, 111-113, 126-127, 136-137 and 146 of copending Application No.09/679,039. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites transmitting ad-statistical data. Calculating and transmitting statistical data it is old and well known in business in order to calculate and transmit statistical data in order to make educated assumptions and statements on a particular subject. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to

have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

4. Claims 1, 18, 29, 30, 32-34, 45, 46, 74-77 and 83-85 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No.09/679,038. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application further recites an ad link history display window that lists links to the sources of advertisements that the user has previously visited. Listing the sources of advertisements or information that the user has previously visited it is old and well known in order to keep track of the success of the different sources of advertisements. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have included a display window that lists links to the sources of advertisements that the user has previously visited in order to achieve the above mentioned advantage.

5. Claims 1, 18, 29, 30, 32-34, 45, 46, 74-77 and 83-85 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of copending Application No.09/728,693. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application further recites that the advertisement download communication link and the data communication link are separate communication links. It is old and well known in the communication and networking arts to have various communication links because such a modification would allow for easier transmission of

data. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have link are separate communication links in order to achieve the above mentioned advantage.

6. Claims 1, 18, 29, 30, 32-34, 45, 46, 74-77 and 83-85, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 and 51-53 of copending Application No.09/668,553. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites transmitting ad obscured ad monitor function that determines whether an obscured ad condition has occurred, whereby the obscured ad condition occurs when an advertisement current being displayed on the display associated with the client device is being obscured by one or more other items currently being displayed on the display and an obscured nag function that generates an obscured ad nag display in response to detection of the obscured ad condition, wherein the obscured nag display notifies the user of the obscured ad condition. Since, monitoring and displaying various advertisements which can occupy the entire portion of the display along with banner advertisements is obvious in on-line advertisements then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included detecting if a displayed advertisement such as a banner advertisements is being obscured by an advertisement and notifying the user in order for the user to be aware that might not be compensated for viewing the banner advertisements that is being obscured by the advertisement.

7. Claims 1, 18, 29, 30, 32-34, 45, 46, 74-77 and 83-85 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-33, 59 and 62 of copending Application No.09/668,331. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites a playlist that identifies the advertisements to be downloaded. Identifying or selecting the advertisements to be downloaded is obvious and well known in order to provide some sort of order within the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

8. Claims 1, 18, 29, 30, 32-34, 45, 46, 74-77 and 83-85 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 46-70 and 74-76 of copending Application No.09/668,632. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites an e-mail function for receiving and sending e-mail to other client devices. Sending and receiving e-mail to other clients is old and well known in the computer related arts in order to receive messages immediately from other clients . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving and sending e-mail messages in order to achieve the above mentioned advantage.

9. Claims 1, 18, 29, 30, 32-34, 45, 46, 74-77 and 83-85 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being

unpatentable over claims 36-70, 74-76 and 78 of copending Application No.09/668,515. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application further recites three operating modes. Different operating modes such as Online and offline operating modes are known in the computer related arts in order to provide different states of the program. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving and sending e-mail messages in order to achieve the above mentioned advantage.

10. Claims 1, 18, 29, 30, 32-34, 45, 46, 74-77 and 83-85 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,9-11,14-24,43,45-54,77-79,81,82,84,86-92,94,95,97-105,107-109 and 111 of copending Application No.09/668,631. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites a playlist that identifies the advertisements to be downloaded. Identifying or selecting the advertisements to be downloaded is obvious and well known in order to provide some sort of order within the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

11. Claims 1, 18, 29, 30, 32-34, 45, 46, 74-77 and 83-85 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-53 of copending Application No.09/668,600. Although the

conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites a third operating mode in which the software switches the operating from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode. Official notice is taken that it is old and well known in the computer related arts to switch from one operating mode to another operating mode that has less features when a problem arises with one of the operating mode because such a modification would allow the software to operate with less features and in that case less problems are less likely to occur. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included switching from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode in order to obtain the above mentioned advantage.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 18, 29-30, 32-34, 45, 74-77 and 83 are rejected under 35 U.S.C. 102(b) as being anticipated by Marsh et al. (5,848,397 hereinafter Marsh).

With respect to claim 1, Marsh teaches Marsh teaches software for use on a client device that is configured for communications with a multiplicity of other client devices via a communication network (Abstract). At least one ad server that stores the advertisements to be distributed to the client devices, each advertisement being stored in a storage location designated by a source address (Figure 8); at least one playlist server that receives the playlist request from each of the client devices, and that transmits a playlist response in response to each playlist request (Figure 8 and col. 15, lines 10-20); and wherein the playlist response transmitted to each client device included at least one playlist that identifies advertisements to be downloaded by that client device (col. 15, lines 1-10).

With respect to claims 18,29, 30, Marsh further teaches that the advertisement being stored in a storage location designated by a uniform resource identifier (col. 8, lines 47-63).

With respect to claims 32-34, 45, 74-76, 83, Marsh further teaches that the playlist is received at prescribed playlist check intervals and each advertisement is limited to a prescribed maximum time duration (col. 3, lines 28-37).

With respect to claim 77, Marsh further teaches that the client device is online for the purpose of sending and/or receiving e-mail messages (i.e. Showcase advertisements are invoked when Online)(col. 7, lines 1 to col. 8, lines 1-11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 46, 84-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh.

Claim 46 further recites a first state and a second state whereby the client device merges its current playlist in the first state and does not merge its playlist in a second state. Marsh teaches displaying the playlist in different fashion. With respect to switching from one mode to a different mode based on the merging of the playlist versus not merging the playlist. Official notice is taken that it is old and well known in the computer related arts to switch from one operating mode to another operating mode when different functions are being performed. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included as one of the choices switching the operating from a first operating mode to a second operating mode, wherein the second operating mode in order to obtain the above mentioned advantage.

Claims 84-85 further recite displaying at least ones of the advertisements in a linear manner or random manner. Official notice is taken that it is old and well known to display in a linear manner or random manner in order to provide an output that is

proportional. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included recites displaying at least ones of the stored advertisements in a linear manner or ransom manner in order to achieve the above mentioned advantage.

Response to Arguments

14. The Double patenting rejections are sustained. Applicant is reserving response to the provisional rejections until all other issues of patentability are settled in all applications. Therefore the double patenting rejections are sustained.

15. Applicant argues that Marsh doesn't teach that the advertisements are downloaded by a client device. The Examiner respectfully disagrees with Applicant because Marsh teaches the client device 101 connecting and requesting showcase advertisements by connecting establishing connection to server system 104 (col. 66 to col. 7, lines 1-6).

16. Applicant argues that Marsh doesn't teach one ad server that stores the advertisements to be distributed to the client devices, each advertisement being stored in a storage location designated by the source address. The Examiner respectfully, disagrees with Applicant because Marsh further teaches on col. 16, lines 20-33, "The advertisement download scheduler is located at the server system 104. The advertisement download scheduler controls the transfer of advertisements from a mail server M.sub.n to a client system 101. At any moment in time, each client system 101 has a given number of advertisements that actually have been downloaded to the client

system 101 and a given number of advertisement eligible for download (as determined by the advertisement distribution scheduler) that are stored on a mail server M.sub.n. Upon any given connection between the client system 101 and the server system 104, the advertisement download scheduler decides which of the advertisements (e.g., the advertisement archives) that are stored on the mail server M.sub.n, if any, are actually downloaded at that time".

17. Applicant argues that Marsh doesn't teach a scheduler that transmits a playlist response to a client device that includes a least one playlist that identifies advertisements to be downloaded by that client device. The Examiner respectfully disagrees with Applicant because Marsh teaches on col. 15, lines 53, "The advertisement distribution scheduler is located at the server system 104. The advertisement distribution scheduler generates an assignment of advertisements to users and their computers. For example, a particular advertisement for orange juice may be assigned by the advertisement distribution scheduler to all residents of New York City and all college students in Boston. Each advertisement has associated with it an ad contract which specifies a demographic profile reach and frequency, duration and time of expiry for the advertisement. The ad contract can be stored in the database management system 106. Using the information about each user received by the server system 104, the advertisement distribution scheduler assigns advertisements to users. In the representative embodiment, the advertisement distribution scheduler uses information received from the user via the member profile that is stored in the database management system 106 to allocated advertisements. Demographic

information collected from other sources can also be used by the advertisement distribution scheduler. Thus, the advertisement distribution scheduler runs database selects on the user demographic information stored in the database management system 106 to produce a list of users for each advertisement".

18. Applicant argues that Marsh doesn't teach intervals of when the advertisements are be downloaded to the client device. The Examiner disagrees with Applicant because since the scheduler manages the amount of ads to transmit at any given time (col. 3, lines 28-37) then it must take into account the space of time between the ads so that the ads won't interfere with one another.

19. With respect to claim 46, The Examiner wants to point out that Marsh teaches downloading the advertisements based on certain characteristics, foe example, high priority versus low priority (col. 3, lines 28-37) and that therefore it would have been obvious to have included switching from one mode to a different mode based on the merging of the playlist because such a modification would allow for manipulation of the current playlist based on the user's choice.

20. Applicant argues that Marsh doesn't teach a response sent by a server to a client that specifies the order in which the advertisements are to be displayed. The Examiner respectfully disagrees with Applicant because Marsh teaches that the advertisement distribution scheduler located at server system 104 determines which advertisements to download to the user, such as high or low priority ads, this determination indirectly

determines the ads to be displayed and the order of the ads to be displayed based on the ads that are downloaded to the client's system.

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
9/20/04